

## **REMARKS**

Reconsideration of the subject application in view of the present amendment is respectfully requested.

With the present amendment, Claim 19 has been amended to clarify the language therein.

Based on the foregoing amendments and the following remarks the application is deemed to be in condition for allowance and action to that end is respectfully requested.

### **I. Rejection Under 35 U.S.C. §112**

The Examiner rejected claims 2-19 under 35 U.S.C. §112, second paragraph, for allegedly being indefinite, asserting that the claim language in claim 19 does not commensurate with the specification. As noted above, claim 19 has been amended to clarify the language therein. Specifically, claim 19 now recites that in their release position, “the at least two clamping members (20) release the stem (4)” of the fastening element, which is consistent with the specification. The specification discloses that upon displacement of the clamping members in a direction opposite the drive-in direction, the radial

spacing between the two clamping members increases (page 22, lines 10-17).

I.e., the clamping members move away from each other, releasing the stem.

It is respectfully submitted that claim 19 and claims 2-18 dependent on claim 19, directly or indirectly, comply with all of the requirements of 35 U.S.C. §112 and is respectfully requested that the rejection under 35 U.S.C. §112 be withdrawn.

## **II. Rejection Over the Prior Art**

The Examiner rejected Claims 10, 11 and 19 under 35 U.S.C. §102(b) as being anticipated by Petkovich, U.S. Patent No. 3,998,467 (Petkovich). Claims 2-3 and 4-6 were rejected under 35 U.S.C. §103(a) as being unpatentable over Petkovich in view of, respectively, Folz, U.S. Patent No. 6,458,022 (Folz) and Stevens, U.S. Patent No. 2,704,003 (Stevens). It is respectfully submitted that claims 2-19 are patentable over the cited references.

Specifically, claim 19 recites that “the clamping members have at least one contact region which forms, at least in the support position of the clamping members (20), a frontmost stop of the holding device (10) in the drive-in direction (22) of the power tool (2) for engaging a workpiece the fastening

element is being driven into, whereby the workpiece applies to the clamping members (20) the force in the direction opposite the drive-in direction.

No such clamping members are disclosed in Petkovich.

Petkovich discloses a drilling tool and not a screw-driving tool and for that reason alone is not believed to be particularly relevant to the present invention. Further, in Petkovich, the clamping members (27) have no region that would contact a workpiece. The clamping members (27) are displaced to their support position by a force acting in a direction opposite the operational drilling direction (column 3, lines 5-11), and displaced to their release position by a force acting in the operational direction (column 3, lines 22-25).

A rejection based on U.S.C. §102 as in the present case, requires that the cited reference disclose each and every element covered by the Claim. Electro Medical Systems S.A. v. Cooper Life Sciences, 32 U.S.P.Q. 2d 1017, 1019 (Fed. Cir. 1994); Lewmar Marine Inc. v. Barient Inc., 3 U.S.P.Q. 2d 1766, 1767-68 (Fed. Cir. 1987); Verdegaal Bros., Inc. v. Union Oil Co., 2 U.S.P.Q. 2d 1051, 1053 (Fed. Cir. 1987). The Federal Circuit has mandated that 35 U.S.C. §102 requires no less than “complete anticipation . . . [a]nticipation requires the presence in a single prior art disclosure of all elements of a claimed invention

arranged as in the claim.” Connell v. Sears, Roebuck & Co., 220 U.S.P.Q. 193, 198 (Fed. Cir. 1983); See also, Electro Medical Systems, 32 U.S.P.Q. 2d at 1019; Verdegaal Bros., 2 U.S.P.Q. 2d at 1053.

Petkovich, assuming *arguendo* that it is a pertinent reference, does not disclose holding device as claimed. Petkovich does not disclose all elements of claim 19, no does the elements are arranged as in claim 19. Since Petkovich fails to disclose each and every feature of independent Claim 19, Petkovich, as a matter of law, does not anticipate the present invention, as defined by said independent claim.

In view of the above, it is respectfully submitted that Petkovich does not anticipate or make obvious the present invention a defined in Claim 19, and the present invention is patentable over Petkovich.

The secondary references likewise do not disclose the present invention as claimed.

Claims 2-6 and 10-11 depend on claim 19 and are allowable or being dependent on an allowable subject matter. Claims 7-9 and 12-18 were found to be allowable.

## CONCLUSION

In view of the foregoing, it is respectfully submitted that the application is in condition for allowance, and allowance of the application is respectfully requested.

Should the Examiner require or consider it advisable that the specification, claims and/or drawings be further amended or corrected in formal respects in order to place the case in condition for final allowance, it is respectfully requested that such amendment or correction be carried out by Examiner's Amendment and the case passed to issue. Alternatively, should the Examiner feel that a personal discussion might be helpful in advancing this case to allowance, the Examiner is invited to telephone the undersigned.

Respectfully submitted,



Alexander Zinchuk

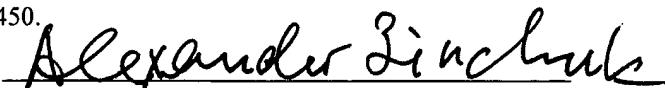
Reg. No. 30,541

Dated: July 12, 2006

Abelman, Frayne & Schwab  
666 Third Avenue, 10th Floor  
New York, NY 10017-5621

212-885-9383

This correspondence is being deposited with the United States Postal Service on July 12, 2006 in an envelope as "Express Mail Post Office to Addressee" Mailing Label Number **ER 059 677 043 US** addressed to the Honorable Commissioner for Patents, Alexandria, VA 22313-1450.



Alexander Zinchuk